



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	)	Group Art Unit: 1712
Takuman, Osamu, et al.	)	
Serial Number: 10/044,199	)	Examiner: Zimmer
Filed: January 9, 2002	)	
Title: ADHESIVE FOR SILICONE RUBBER	)	REMARKS
Attorney Docket: TSL - 1695	)	May 6, 2003

RECEIVED  
MAY 15 2003  
GROUP 1700

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The applicant has studied the office action and the references and can make the following remarks.

The applicant has noted the similarity of the Japanese reference and has amended claim 1 by removing untreated calcium carbonate.

Claim 6 has been amended to change the form of the claim into a Markush format.

The applicant notes that the claims being considered by the Examiner are claims 1 to 10, all of the claims in the application. The examiner has rejected claims 1, 3, 6, 7 and 10 and has objected to claims 2, 4, 5, 8, and 9.

Claims 1 and 6 have been rejected under 35 U.S.C. 102(b) as being anticipated by Nishiumi et al, U.S. Patent 6,166,121. The Examiner notes that Nishiumi discloses a curable organopolysiloxane composition that exhibits improved adhesion to various surfaces.

Applicant would note for the Examiner that the reference does not teach the treating of calcium carbonate with an organic acid, or calcium carbonate treated with an ester of an organic acid, but instead teaches the use of a mixture of rosin and fatty acid to

*a fatty acid is  
an organic  
acid*

treat filler. Thus, the reference does not meet the provisions of the law with regard to anticipation under 35 USC 102(b), in that, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). And further, "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPA2d 1913, 1920 (Fed. Cir. 1989). The Nishiumi et al reference does not meet these requirements and therefore, this rejection must be withdrawn.

Turning now to the rejection of the claims 1, 3, 7, and 10 as being rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57-195150A, the applicant would point out to the Examiner that the amendments to the claims take the claim out of the purview of the cited reference in that the instant claims no longer claim untreated calcium carbonate.

The Japanese reference does not teach a method in which treated calcium carbonates are used as part of the composition make-up and therefore, does not teach or suggest the instant invention and this rejection should be withdrawn.

Respectfully submitted,



Robert L. McKellar  
Reg. No. 26,002  
(989) 631-4551